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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,962	10/30/2003	James R. Casciani	009103-009740US	8826
20350	7590	09/01/2004		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER KREMER, MATTHEW J	
			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,962

Applicant(s)

CASCANI ET AL.

Examiner

Matthew J Kremer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/30/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 16 of U.S. Patent No. 5,782,237 to Casciani et al. (Casciani)(cited by Applicant). Claim 1 of Casciani claims a "method for measuring blood oxygen saturation, comprising the steps of: providing a sensor and a pulse oximeter; selecting a light source and a light detector...; optimizing a wavelength spectrum of light received by said light detector from said light source for an oxygen saturation reading less than 80 percent...; placing said sensor on a patient; and determining said blood oxygen saturation said sensor and said pulse oximeter."

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of Casciani claims a method, which is narrower in scope than the present application. Claim 1 of Casciani meets all the limitations set out in

claim 1 of the present application and it would be obvious that one who is practicing the method of claim 1 of Casciani is actually practicing the method of claim 1 of the present invention. Claim 16 of Casciani claims a “method for measuring blood oxygen saturation, comprising the steps of: providing a sensor and a pulse oximeter; selecting a light source and a light detector...; optimizing a wavelength spectrum of light received by said light detector from said light source for an oxygen saturation reading less than 80 percent...; placing said sensor on a patient; and determining said blood oxygen saturation using said sensor and said pulse oximeter”. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 of Casciani claims a method, which is narrower in scope than the present application. Claim 16 of Casciani meets all the limitations set out in claim 1 of the present application and it would be obvious that one who is practicing the method of claim 16 of Casciani is actually practicing the method of claim 1 of the present invention.

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,421,329 to Casciani et al. (Casciani) in view of U.S. Patent 5,058,588 to Kaestle in view of U.S. Patent No. 5,575,285 to Takanashi et al. (Takanashi). Claim 1 of Casciani claims a “method for using a pulse oximeter to measure blood oxygen saturation, comprising the steps of: providing a sensor and a pulse oximeter; selecting a light source for said sensor...placing said sensor on a patient; and determining said blood oxygen saturation using said sensor and said pulse oximeter”. Claim 1 does not claim the step of

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selecting a light detector but does claim a sensor with a pulse oximeter. It is well known in the art that the art of pulse oximetry includes the selection of a light detector to detect the light transmitted through or reflected from tissue since oxygen saturation measurements are derived from the light detector signals. (column 1, lines 12-30 of Kaestle). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the selection of a light detector as disclosed by Kaestle since oxygen saturation measurements are derived from the light detector signals. Claim 1 of Casciani claims the step of "optimizing a wavelength spectrum of said light source for an oxygen saturation reading less than 80 percent" but does not claim the step of "optimizing a wavelength spectrum of light received by said light detector from said light source for an oxygen saturation reading less than 80 percent". It is well known that when light sources are optimized for a particular wavelength spectrum, the light detector is similarly optimized to those light sources so that the measurements can be carried out in bright places. (column 3, lines 45-57 of Takanashi). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the selection of the light detectors as disclosed by Takanashi since oxygen saturation measurements can then be carried out in bright places.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,623,248 to Sperinde. (cited by the Applicant). Sperinde teaches the steps of providing a sensor (catheter) and a pulse oximeter (2), selecting a light source (LEDS 4,6,8), and selecting a light detector (32). (Fig. 4 of Sperinde). Sperinde teaches the step of optimizing a wavelength spectrum of light for an oxygen saturation reading less than 80 percent in the form of selecting the appropriate equations and wavelengths for particular range of oxygen saturation readings. (Figs. 5A-5B of Sperinde).

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,446,871 to Imura. Imura teaches the steps of providing a sensor (the optical fiber of Fig. 1 of Imura) and a pulse oximeter (Fig. 3 of Imura), selecting a light source (reference numeral 1 of Fig. 1 of Imura), and selecting a light detector (reference numeral 13 of Fig. 1 of Imura). Sperinde teaches the step of optimizing a wavelength spectrum of light for a particular oxygen saturation range. (column 9, lines 22-50 of Imura).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kremer whose telephone number is 703-605-0421. The examiner can normally be reached on Mon. through Fri. between 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 703-308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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ERIC F. WINAKUR
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